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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/537,176	03/29/2000	Marco Caeran	P18888	6098

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EXAMINER

MOHANDESI, JILA M

ART UNIT	PAPER NUMBER
3728	

DATE MAILED: 04/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/537,176	CAERAN, MARCO <i>CH</i>
	Examiner	Art Unit
	Jila M. Mohandes	3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 22 January 2002.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-20,24-27,29 and 30 is/are pending in the application.

4a) Of the above claim(s) 15,19 and 20 is/are withdrawn from consideration.

5) Claim(s) 1-14,16-18,24-27,29 and 30 is/are allowed.

6) Claim(s) _____ is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 09 July 2001 is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

 If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

 1. Certified copies of the priority documents have been received.

 2. Certified copies of the priority documents have been received in Application No. _____.

 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

 a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Continued Prosecution Application

1. The request filed on 22 January 2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/537,176 is acceptable and a CPA has been established. An action on the CPA follows.

Election/Restrictions

2. This application contains claims 15, 19-20 drawn to an invention nonelected with traverse in Paper No. 5. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Objections

3. Claim 2 is objected to because of the following informalities: In claim 2, line 7, the word "the" is repeated twice. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 3-18, 24-27 and 29-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrase "at about mid-height of a tibia area of the boot" is vague and indefinite. It is not clear what structure such language would encompass.

In claims 13 and 14, the phrase "wherein the external upper extends above an ankle region to about a middle region of a tibia of the user" is vague and indefinite and inaccurate. It is

not clear what structure such language would encompass since this height will vary from one user to the next.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. It is noted that the term "sports boot" in the preamble has been accorded no weight in the examination in keeping with the courts instructions in *Kropa v. Robie*, 187 F.2d 533, 88 USPQ 478.

8. Claims 1, 3-14, 18, 24-27 and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reinhart et al. (2,261,453) in view of Bourdeau (5,887,886). Reinhart '453 discloses a boot comprising an outer sole **B** and an external upper **A** covering a user's foot and lower leg, the external upper comprising a flexible frame **C** made of a flexible, substantially non-stretchable material, arranged along determinate directions of forces transmitted during use of the boot, said flexible frame being affixed to both the external upper and the outer sole, the flexible frame comprising a dorsal portion (see Figure 2 embodiment) comprising at least one lateral arm laterally connecting an upper end of the dorsal portion to one side of the boot (note the lateral arms **1** connecting an upper end of the dorsal portion to one side of the boot, Figure 2 embodiment). Reinhart '453 does not appear to show the dorsal portion extending from the outer sole substantially up to a top end of the external upper at about mid-height of a tibia area of the boot. Bourdeau '886 discloses a frame where the dorsal portion extends from the outer sole

substantially up to a top end of the external upper at about mid-height of a tibia area of the boot and bearing a wide scallop **44** at the level of the heel so as to allow the positioning of shock absorbing means at this level, and to allow tactile sensations of the heel (see Figure 2 embodiment). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the dorsal portion of Reinhart '453 extend from the outer sole substantially up to a top end of the external upper at about mid-height of a tibia area of the boot and bearing a wide scallop at the level of the heel of the flexible frame as taught by Bourdeau '886 so as to allow the positioning of shock absorbing means at this level, and to allow tactile sensations of the heel.

With regard to claims 13 and 14 which further limits the height of the external upper, this would be a design choice depending on the type of sport the footwear is being used for and as a matter of routine optimization.

With regard to claims 25, 26, 29 and 30 which further limit the material of the flexible frame; it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

In re Leshin, 125 USPQ 416.

9. Claims 1-14, 16-18, 24-27 and 29-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoshizaki et al. (5,498,033) in view of Bourdeau '886. Hoshizaki '033 discloses all the limitations of the claims such as a sports boot that permits a certain amount of dorsal and plantar flexion, comprising an outer sole and an external upper overlying the outer sole and covering a user's foot and lower leg, the upper including a flexible (capable of bending during use), plastic (which is substantially non-stretchable, since it improves the overall strength and

rigidity of the skate boot) frame 1 having several cut-out areas which allow for a certain amount of flexion, the flexible frame comprising a dorsal portion comprising at least one lateral arm (7) laterally connecting an upper end of the dorsal portion to one side of the boot. See column 2, lines 11-13 and Figures 1 and 4 embodiments. Hoshizaki '033 does not appear to show the dorsal portion extending from the outer sole substantially up to a top end of the external upper at about mid-height of a tibia area of the boot. Bourdeau '886 discloses a frame where the dorsal portion extends from the outer sole substantially up to a top end of the external upper at about mid-height of a tibia area of the boot and bearing a wide scallop 44 at the level of the heel so as to allow the positioning of shock absorbing means at this level, and to allow tactile sensations of the heel (see Figure 2 embodiment). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the dorsal portion of Hoshizaki '033 extend from the outer sole substantially up to a top end of the external upper at about mid-height of a tibia area of the boot and bearing a wide scallop at the level of the heel of the flexible frame as taught by Bourdeau '886 so as to allow the positioning of shock absorbing means at this level, and to allow tactile sensations of the heel.

With regard to claims 13 and 14 which further limits the height of the external upper this would be a design choice depending on the type of sport the footwear being used for.

With regard to claims 16 and 17, note recess 5 and 15 and notch 8 in Figure 4 embodiment.

With regard to claims 25, 26, 29 and 30 which further limit the material of the flexible frame; it has been held to be within the general skill of a worker in the art to select a known

material on the basis of its suitability for the intended use as a matter of obvious design choice.

In re Leshin, 125 USPQ 416.

Response to Arguments

10. Applicant's arguments with respect to claims 1-14, 16-18, 24-27 and 29-30 are have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shown is footwear with frames analogous to the applicant's instant invention.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M. Mohandesu whose telephone number is 703-305-7015.

The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Jila M. Mohandesu
Examiner
Art Unit 3728

JMM
April 3, 2002

J. Mohandesu
J. Mohandesu
Patent Examiner